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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,720	08/18/2003	Stephen D. Highfill	HM-76623	4690

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EXAMINER

RICHARDSON, JOHN A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,720

Applicant(s)

HIGHFILL ET AL.

Examiner

John Richardson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13, 15-18, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 14 and 19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Non Final Rejection

1). Applicant's election with traverse of Group II, reading on claims 13-21 in the applicant's response dated March 08 2004 is acknowledged. The traversal is on the grounds are that the claimed weapon mount system provides and underlying structure for the apparatus claims making it *difficult* (emphasis added) to operate the weapon without the system claims and that searching of the cited Groups I, II would be *coextensive* (emphasis added). This is not found persuasive because as stated in Office action dated February 04 2004, the cited Groups I, and II are considered to be clearly combination and subcombination structures and in addition the subcombination has a separate utility such as a rifle sighting apparatus.

The requirement is still deemed proper and is therefore made FINAL.

2). Claims 1-12 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in applicant's response dated March 08 2004.

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3). The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4). Claims 13, 15, 17, 18, 20, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller (U.S. 5,070,636).

The applicant's claims are directed to an assembly per se for mounting a pistol or rifle. The reference discloses a gun mount assembly comprising a forward cradle (item 18), a rear support structure configured for a plurality of modes (items 26, 65) comprising rear support cradles (items 35, 71), a mount platform for supporting the pistol mode arrangement (item 67), relating to claim 15, the reference discloses the said rear support with a hollow guide / slot (item 66) for a rigid member configured to slide in the said guide (see Figure 5), relating to claim 17, the reference discloses the said front cradle (item 18) arranged with a threaded shaft height adjuster (item 20) for raising and lowering the said cradle setting, relating to claim 18, the reference discloses the said forward cradle lock for fixing the said cradle position (item 24), relating to claim 20, the reference discloses a tray / table coupling the said gun mount components (item 12), and relating to claim 21, the reference discloses a slide mechanism coupled to the said tray as shown for example in Figure 1, items 14, 40, 44, and 52.

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It is noted in the examining the cited claims that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from prior art apparatus" if the prior art teaches all the structural limitations of the claim. In re Masham, 2 USPQ2d 1647.

Claims directed to apparatus must be distinguished from prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device *is*, not what a device *does*. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP§ 2115, a recitation in a claim to the material or article worked upon, does not serve to limit an apparatus claim.

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5). Claims 13, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Dusen (U.S. 5,489,110).

The applicant's claims are directed to an assembly per se for mounting a pistol or rifle with the intended use for supporting a firearm in a plurality of operating modes.

The reference provides a structure that is inherently capable of operating and functioning in the manner cited in the applicant's claims, comprising a support structure (item 13) with front and rear support cradles / V-shaped supports (items 18), the said cradles / V-shaped supports in an aligned configuration (see for example, 1), a mounting platform (item 16) for the said cradles / V-shaped supports, and the said support structure is capable of being configured in a plurality of modes as shown for example in Figures 2A, 2B, and 2C, and relating to claim 16, the said support structure can be configured to be mounted from a trailer hitch of a vehicle through members items 12, 14, 19.

As to limitations which are considered to be inherent in a reference, note the case law In re Ludke, 169 USPQ 563, In re Swinehart, 169 USPQ 226, In re Fitzgerald, 205 USPQ 594, In re Best et al, 195 USPQ 430, and In re Brown, 173 USPQ 685,688.

6). Claims 15, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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7). The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8). Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Richardson whose telephone number is (703) 305 0764. The examiner can normally be reached on Monday to Thursday from 7.00 AM to 4.30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306 4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 305 7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 1113.

John Richardson, PE,

May 25 2004.



MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER